

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Ephraim GUTMARK *et al.*

Application No.: **10/725,562**

Filing Date: 3 December 2003

For: Method for Affecting Thermoacoustic Oscillations
in Combustion Systems (as amended)

Art Unit: 3749

Examiner: Basichas, Alfred

Attorney Ref. No.: 003-102

Via EFS-Web

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the non-final Office Action dated 10 October 2006, the response period extending through 10 February 2007, Applicant requests a Pre-Appeal Brief Review in accordance with the guidelines set forth in the 12 July 2005 Official Gazette Notice (New Pre-Appeal Brief Conference Pilot Program, 1296 *Off. Gaz. Pat. Office* 67 (July 12, 2005); *see also* Extension of the Pilot Pre-Appeal Brief Conference Program, 1303 *Off. Gaz. Pat. Office* 21 (January 10, 2006)) (collectively, "Notice"). Reconsideration of this application by a three Examiner panel is requested in view of the following remarks which identify the errors in facts, and the omission of essential elements required to establish *prima facie* rejections.

Summary of Office Action and Status of Application

The Office Action includes four rejections: (1) Claims 1-8, under provisional obviousness-type double patenting, over Claims 1-6 of Application No. 10/725,563 ("563 application"); (2) Claims 1-8, under provisional obviousness-type double patenting, over Claims 1-6 of Application No. 10/725,564 ("564 application"); (3) Claims 1-3, 5-8, and 16, under 35

U.S.C. § 102(b) over U.S. Patent No. 6,464,489, issued to Gutmark *et al.* (“Gutmark”); and (4) Claim 4 under 35 U.S.C. § 103(a) over *Gutmark* alone. This application has been twice rejected, and therefore Applicant’s right to appeal has vested.

Summary of the Claimed Invention

As requested in the Notice, a summary of the claimed invention can be found in Applicant’s Amendment and Response filed 14 August 2006, at pages 4-5 and 6-7.

Omission of Essential Elements Required for a *prima facie* case, Necessitating Review

The Office Action fails to present essential elements needed to support the rejections therein, which omissions necessitate review and withdrawal of the Office Action.

Provisional Obviousness-type Double Patenting Rejections ((1) and (2))

M.P.E.P. § 804 *et seq.* set out the minimum requirements for a double-patenting rejection in an Office Action. A brief review of the Office Action’s rejections reveals that the rejections are so deficient that Applicant has not been fully apprised of the grounds of the rejection, and therefore has been denied the opportunity to fully respond. Subsection II(B)(i) of M.P.E.P. § 804 instructs:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

The entirety of the explanations offered in the Office Action is, in fact, only the boilerplate in the form paragraph appropriate for such rejections (8.35). Indeed, that form paragraph's instructions are for the patent examiner to provide an explanation of why it is the examiner's opinion that the claimed subject matters are allegedly patentably indistinct; instead of providing that required element of the rejection, the Office Action ends the form paragraph with a period, even deleting the word "because", thus purposefully not providing the required explanation. To exacerbate the deficiencies in these rejections, in a Response to Arguments section of the Office Action, Mr. Basichas essentially punts on his obligation to examine the patent application, instead stating that it would be more 'expedient' if the Applicant explained why the claims are patentably distinct, rather than he first satisfying the PTO's statutory obligations.

The rejection is thus devoid of any explanation why Claims 1-8 are not separately patentable from Claims 1-6 of the '*563 application* and of the '*564 application*, including what are exactly the differences in their respective subject matters. By these failings, the Office Action has denied the evaluation of Claims 1-8 to which Applicant is entitled (35 U.S.C. § 132; 37 C.F.R. § 1.104), and Applicant also has no substantive positions to rebut.

Rejection under 35 U.S.C. §§ 102, 103

Gutmark does not anticipate the subject matters of Claims 1-3, 5-8, and 16, each of which recites, *inter alia*, modulating fuel injection into a recirculation zone which forms in the combustor. A complete reading of *Gutmark* reveals that it is entirely concerned with using

loudspeakers to acoustically drive shear layers in a combustor, to combat thermoacoustic oscillations. The two passages identified in the Office Action have nothing to do with the claimed subject matter: Col.3, lines 15-31 merely states that, in comparison to modulated fuel injection, *Gutmark*'s method works better in affecting shear layers; and Col. 7, lines 50-63, only acknowledges that combustors of his type include recirculating flow, only to instruct the reader where shear layers are located. Nowhere does *Gutmark* describe the claimed step(s). Despite this, during the recent telephonic interview Mr. Basichas suggested that any injection of fuel into a combustor having recirculation zones would be read on by the claimed method, even though the Office Action is silent on this point. The undersigned pointed out a simple analogy (Mr. Basichas combatively indicated he was not interested in listening to analogies): 'If your office includes an open desk drawer, and if a person blows air into your office, do these two conditions necessarily mean that the person has blown air into your desk drawer?' The answer is clearly 'no', because there is no indication of any of the numerous and myriad details required to conclude, more likely than not, that the hypothetical air was blown into the hypothetical drawer. And, by simple analogy, there is no disclosure in *Gutmark* that his disclosure necessarily includes modulating fuel injection into a recirculation zone which forms in a combustor.

The rejection under section 103(a) is similarly deficient.

Conclusion

Accordingly, the Office Action fails to include essential elements to make out a *prima facie* case, namely (1) any factual allegations to support a (provisional) double-patenting rejection, to which Applicant could respond, and (2) any factual allegations or technical reasoning why *Gutmark* can anticipate the claimed methods.

Conclusion

Applicant respectfully submits that this application is in immediate and clear form for allowance based on the clear errors and omissions cited above. Accordingly, an early indication, via Notices of Allowance and Allowability, that all claims are allowed, is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-2821.

Respectfully submitted,

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